SUPREME COURT, U. S.

FILED

OCT 19 1967

JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1967

No. 741

FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER, GEORGE NEWBOLT ROLINSON,

Petitioners,

—v.—

EDWARD J. BRENNER, Commissioner of Patents,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

ALBERT L. JACOBS
Counsel for Petitioner
521 Fifth Avenue
New York, N. Y. 10017

Of Counsel:
ALBERT L. JACOBS, JR.
521 Fifth Avenue
New York, N. Y. 10017

INDEX

	PAGE
Citations to Opinions Below	1
Jurisdiction	2
Questions Presented	2
Statutes Involved	3
Statement	4
Reasons for Granting the Writ	7
CONCLUSION	19
APPENDIX A	
Statutes and Patent Office Rules	21
APPENDIX B	
Opinions Below Including That of Administrative Agency	30
APPENDIX C	
Patent Office Advisory Action Admitting *Prima Facie* Evidence Submitted and M. P. E. P. Section 1101.02(a)	38

CITATIONS

PAGE

Cases:

Agnew v. Board of Governors of the Federal Reserve System (CA D. C. 1946), 153 F. 2d 785, rev'd other grounds 329 U. S. 441 11

Apstein v. Brimley and Cance (PO Bd. Pat. Inter.), 133 U. S. P. Q. 604 16

Barefield v. Byrd (CA Miss. 1963), 320 F. 2d 455, cert. den. 376 U. S. 928 8

Brenner, Commissioner of Patents v. Manson (1966), 383 U. S. 519 ..... 16, 18

Butterworth, Commissioner of Patents v. United States ex rel. Hoe et al., 112 U. S. 50 12

Cobb v. U. S. (DC Ark.), 240 F. Supp. 574 9

Commissariat A L'Energie Atomique v. Watson, Commissioner of Patents (CA D. C. 1960), 274 F. 2d 594 11

Connelt v. City of Jerseyville (CA Ill. 1942), 125 F. 2d 121 11

Cramer v. Kirkwood and Torre (CCPA), 305 F. 2d 486 16

Estrada v. Ahrens (CA Fla. 1961), 296 F. 2d 690 9

Freeman v. Brown (CA Ga. 1965), 342 F. 2d 205 8

General Motors Corp. v. United States (DC Mich. 1962), 207 F. Supp. 641 9

Goldberg v. Hoffman (CA 7 1955), 226 F. 2d 681 10

Gonzalez et al. v. Freeman, Secretary of Agriculture (CA D. C.), 334 F. 2d 570 10

PAGE

Higginson v. Schoeneman (CA D. C. 1951), 190 F. 2d 32 11

Kingsland, Commissioner of Patents v. Carter Carburetor Corp. (CA D. C. 1945), 168 F. 2d 565, cert. den. 79 U. S. P. Q. 453 12

Parrott v. Cary (DC Colo. 1964), 234 F. Supp. 572 10

Sleeth v. Dairy Products Co. of Uniontown, 228 F. 2d 165, cert. den. 351 U. S. 966 10

Thomas v. Unison (CA D. C. 1946), 153 F. 2d 636 11

United States ex rel. Steinmetz v. Allen, 192 U. S. 543 12

In re Walker (CCPA 1963), 324 F. 2d 977 9

Wenner v. Koch (Commissioner of Patents), 152 U. S. P. Q. 291 ..... 16, 18

In re Wiechert (CCPA), 152 U. S. P. Q. 247 ..... 12, 14

Winkler v. Ladd, Commissioner of Patents (DC D. C. 1963), 221 F. Supp. 550 9

Word v. U. S. (DC Ala. 1963), 223 F. Supp. 614 8

Statutes:

5 U. S. C. 1009 ..... *passim*

28 U. S. C. 1254(1) 2

28 U. S. C. 1361 ..... *passim*

35 U. S. C. 101 17

35 U. S. C. 112 17

PAGE

35 U. S. C. 133 11

35 U. S. C. 135 ..... 3, 6, 14

35 U. S. C. 145 ..... 13, 14

Miscellaneous:

Moore's Federal Practice, Vol. 7A JC-535 10

Patent Office Rules:

Rules 181 to 183 ..... 3, 16

Rule 201 ..... 3, 6, 17

Rule 204 ..... 4, 6, 15, 16, 17, 18

Patent Office Manual of Patent Examining Procedure Section 1101.02(a) 17

IN THE

Supreme Court of the United States

October Term, 1967

No. .....

FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER, GEORGE NEWBOLT ROLINSON,

Petitioners,

—v.—

EDWARD J. BRENNER, Commissioner of Patents,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

Petitioners pray that a writ of certiorari issue to review the decision of the United States Court of Appeals for the District of Columbia, rendered in the above entitled case on July 21, 1967.

Citations to Opinion Below

The decision of the Court of Appeals for the District of Columbia is reported at 154 U. S. P. Q. 464 and is printed for convenience in Appendix B hereto, page 30. The decision of the District Court for the District of Columbia is unreported and is printed in Appendix B hereto, page 34. The decision of the Commissioner of Patents, constituting

the agency action judicial review of which is requested, is unreported and is printed in Appendix B hereto, page 35.

Jurisdiction

The decision of the Court of Appeals for the District of Columbia was rendered on July 21, 1967 (App. B, page 30). No petition for rehearing has been filed. The jurisdiction of this court is invoked under 28 U. S. C. 1254 (1).

Questions Presented

1. Whether decisions of the Commissioner of Patents or his delegate in response to a properly framed petition, invoking the jurisdiction of the Commissioner under his own rules are to be exempted from judicial review by the Federal Courts in the absence of any statute so specifying, even though such decisions are final and not otherwise reviewable.

2. Whether foreign applicants for United States patents are to be denied judicial review of an otherwise unreviewable act of an Administrative Agency, i.e., the Patent Office as represented by the Commissioner of Patents, when the jurisdiction of the Federal Court has been invoked under 28 U. S. C. 1361 singly or in conjunction with 5 U. S. C. 1009.

3. Whether federal judicial review of an administrative decision should be denied on the sole ground that different issues could still be litigated in a quasi-judicial proceeding all of which different issues would be rendered moot by a favorable decision in the judicial review action.

4. Whether under 35 U. S. C. 135 foreign applicants for United States patents should be denied the opportunity to contest the question of first inventorship with a United States patentee because while said applicants have submitted *prima facie* evidence of first inventorship in compliance with the Patent Office Rules, which fact has been admitted by the Patent Office, they have not submitted *conclusive* evidence.

5. Whether under 35 U. S. C. 135 a request for an Interference between a pending United States patent application and an issued United States patent can properly be denied on the sole ground that the pending application is unpatentable over the very patent with which an Interference has been requested when said application is allowable in all other respects as required by Patent Office Rule 201, and is in full compliance with all laws and all rules of the Patent Office as to patentability.

Statutes Involved

The following statutory provisions and Rules of the United States Patent Office are involved:

5 U. S. C. 1009

28 U. S. C. 1361

35 U. S. C. 135

Rules 181 to 183 of the Rules of Practice of the United States Patent Office

Rule 201 of the Rules of Practice of the United States Patent Office

Rule 204(b) of the Rules of Practice of the United States Patent Office

They are printed in Appendix A, pages 21 to 29.

Statement

Doyle, Nayler and Rolinson, British subjects, filed a patent application in the United States Patent Office which the Patent Office has agreed is entitled to an effective filing date of August 2, 1957. This application contains, *inter alia,* six claims identical to the only six claims present in Sheehan, United States Patent No. 3,159,617. Before a patent was granted to Sheehan, Doyle, Nayler and Rolinson requested the Patent Office to declare an Interference so that a determination could be made on an *inter partes* basis as to who in fact was the first inventor of subject matter claimed both by Doyle, Nayler and Rolinson, and by Sheehan. The Patent Office, before issuing a patent to Sheehan, suspended prosecution in the Doyle, Nayler and Rolinson case, but without prior warning and without any explanation as to the reasons for such action, the Patent Office improperly issued a patent to Sheehan and rejected the Doyle, Nayler and Rolinson application as unpatentable over the newly issued Sheehan patent. The Patent Office later revealed that it had made a determination on its own that the Sheehan patent was entitled to the benefit of the March 1, 1957 filing date of an earlier filed Sheehan patent application which had been abandoned and that since the filing date of that earlier abandoned Sheehan application was some five months earlier than the August 2, 1957 date given Doyle, Nayler and Rolinson by the Patent Office, an Interference would not be declared. Doyle, Nayler and

Rolinson were refused the opportunity to challenge this ruling before it was finalized and a patent was issued to Sheehan. They have been and still are being denied the right and opportunity to directly question Sheehan as to his right to claim the earlier date that the Patent Office decided, on its own, to give him.

After the Patent Office had issued a patent to Sheehan, Doyle, Nayler and Rolinson again requested an Interference with the now issued Sheehan patent on four occasions. Three affidavits, as well as arguments, have been submitted. These affidavits comprised sworn statements from three of the leading chemists and one, in fact, is from Sir Robert Robinson[1] and proved *prima facie* (Appendix C, page 38[2]) that Sheehan was not and is not entitled to receive the benefit of the March 1, 1957 filing date of his abandoned application, but rather should receive only the benefit of the filing date of the application on which a patent actually issued, which date is almost two years subsequent to the August 2, 1957 effective date of Doyle, Nayler and Rolinson.

---

[1] Robert Robinson Kt., O.M., D.Sc., F.R.I.C., F.R.S., Nobel Prize for Chemistry in 1947, former Professor of Chemistry in the Universities of Sydney, Liverpool, St. Andrews, Manchester, University College, London, Oxford (1932-1947), recipient of 22 honorary doctorates and foreign member of Scientific Academies worldwide, including the National Academy of Sciences, Washington, District of Columbia, American Academy of Art and Sciences, Boston, Massachusetts, New York Academy of Science, Philosophical Society of Philadelphia, Pennsylvania, honorary member of the Chemists Club of New York; affidavits were also filed by John Herbert Charles Nayler, a graduate of London University, B.S. and Ph.D. and a Fellow of the Royal Institute of Chemistry in England and Maurice John Soulal, a graduate of London University, B.S. and Ph.D. and a Fellow of the Royal Institute of Chemistry in England.

[2] See especially App. C, page 40, lines 15 to 18, wherein the Patent Office specifically admits that *prima facie* evidence had been submitted.

The Patent Office rules governing the declaration of Interferences, both between pending applications and between a pending application and an issued patent, are promulgated by the Commissioner of Patents pursuant to 35 U. S. C. 135. These rules have the force of law. Rule 201 governs declarations of Interferences generally. Rule 204 (b) governs the quantum of proof required to obtain the declaration of an Interference. That burden is at most that *prima facie* evidence be presented to show that the party requesting the Interference may prevail as to priority of inventorship if an Interference is declared. The Patent Office refused to declare the requested Interference because the proof presented by Doyle, Nayler and Rolinson, while meeting the *prima facie* showing required by the Rules, did not constitute "a conclusive showing" (App. C, page 40). Since the Doyle, Nayler and Rolinson application was under a final rejection in the Patent Office, in order to prevent the Commissioner from holding their application to be abandoned, Doyle, Nayler and Rolinson filed a Notice of Appeal. After the Notice of Appeal was filed, Doyle, Nayler and Rolinson filed a Petition to the Commissioner of Patents and requested that he review the refusal of the Patent Office Examiners to declare an Interference and that he interpret the Interference Rules newly promulgated by him, which had not hitherto been interpreted. The Commissioner delegated the decision on the Petition back to the very section of the Patent Office which had refused to declare the Interference. The Petition was denied and no rule interpretation was issued.

Doyle, Nayler and Rolinson then filed an action in the District Court for the District of Columbia under the provisions of 28 U. S. C. 1361 (Action in the Nature of Mandamus) and/or 5 U. S. C. 1009 (Administrative Procedure

Act) requesting that the District Court exercise its jurisdiction to review the refusal of the Commissioner of Patents to act.

A temporary restraining order staying the Appeal proceeding before the Patent Office Board of Appeals which resulted from the required filing of a Notice of Appeal was signed by District Court Judge Jackson. Doyle, Nayler and Rolinson filed a Motion for a Preliminary Injunction to stay the Board of Appeals proceedings pending outcome of their court action. During Oral Argument, the Patent Office Solicitor offered to join in a request with Doyle, Nayler and Rolinson that the Board of Appeals stay its proceedings. Such a request was filed and all proceedings before the Board have been suspended pending final determination of the case by the Supreme Court.

On a Motion to dismiss brought by the Commissioner of Patents, the District Court dismissed the action.

Doyle, Nayler and Rolinson filed an Appeal to the Court of Appeals for the District of Columbia and the Court of Appeals affirmed the District Court's dismissal.

Reasons for Granting the Writ

1. The District Court and the Court of Appeals for the District of Columbia have refused to review the action of the Commissioner of Patents in refusing to declare an Interference between a pending patent application and an issued patent after all the Commissioner's rules had been complied with and have also refused to review the Commissioner's refusal to interpret his Interference Rules. In seeking Court review, Doyle, Nayler and Rolinson relied

upon 5 U. S. C. 1009 and 28 U. S. C. 1361. 5 U. S. C. 1009 provides for judicial review of Administrative agency action, except insofar as a statute specifically precludes judicial review or insofar as the agency action is by law committed to agency discretion.

A statute purporting to preclude judicial review must clearly demonstrate that such was the intention of Congress. See *Freeman* v. *Brown* (CA Ga. 1965), 342 F. 2d 205 and *Barefield* v. *Byrd* (CA Miss. 1963), 320 F. 2d 455, cert. den. 376 U. S. 928. In *Word* v. *U. S.* (DC Ala. 1963), 223 F. Supp. 614 the District Court sitting in Alabama found that it had the right and duty upon proper application to judicially review the action of any administrative agency.

The Commissioner has failed to point out any statute which specifically exempts his action from judicial review. His action is not committed to agency discretion. It is, therefore, important for Federal jurisdiction to be exercised so that administrative agencies may not be allowed to run untrammeled over applicants who appear before them. While the present case deals only with a decision of the Commissioner of Patents, the case as a whole has wider application, because if the Commissioner of Patents may refuse to act in response to a properly framed Petition invoking action and if this refusal to act is unreviewable, any other government agency can act in a similar manner and thereby insulate itself from Federal judicial review by merely declining to act, thus leaving the aggrieved party without any viable remedy.

5 U. S. C. 1009 has in the past been used as a proper basis for obtaining judicial review of actions of the Commis-

sioner of Patents. Moreover, the Federal Bar News, Volume 13, No. 2, February 1966 at page 77, states that defending actions seeking review of decisions of the Commissioner of Patents under the Administrative Procedure Act is an integral part of the job of the Patent Office Solicitor.

In the case of *In re Walker* (CCPA 1963), 324 F. 2d 977, the Solicitor himself suggested that review of the matter in question might be had by Petition to the Commissioner followed by a civil action in the District Court for the District of Columbia under 5 U. S. C. 1009. (See especially page 985, note 2.) In *Winkler* v. *Ladd, Commissioner of Patents* (DC D. C. 1963), 221 F. Supp. 550, the District Court for the District of Columbia accepted jurisdiction of an action under 5 U. S. C. 1009 which sought review of the Commissioner of Patents' refusal to revive an abandoned patent application (which is an area in which the Commissioner possesses a good deal of discretion).

The Federal Courts have jurisdiction to set aside arbitrary or capricious agency action. See *General Motors Corp.* v. *U. S.* (DC Mich. 1962), 207 F. Supp. 641; *Estrada* v. *Ahrens* (CA Fla. 1961), 296 F. 2d 690. In *Cobb* v. *U. S.* (DC Ark.), 240 F. Supp. 574, the Court specifically stated that the Administrative Procedure Act, namely Sections 1001 et seq. deals with judicial review of any act or order of an administrative agency which aggrieves or injures any party and which action is not specifically excluded by Congress from judicial review. Petitioners' case is of particular widespread importance because foreign applicants who are already discriminated against by U. S. C. 104, wherein foreign applicants are prohibited from proving dates on which work was actually done outside the United

States on their invention, are here being denied due process of law. The principles involved in this case also affect United States applicants. The questions of rule interpretation and burden of proof will continue to arise as long as Interferences are still a part of our patent law.

5 U. S. C. 1009 was enacted to protect applicants before all administrative agencies from insulation by that agency against judicial review of its decisions.

In a very recent case decided in 1964 by the Court of Appeals for the District of Columbia, *Gonzalez et al.* v. *Freeman, Secretary of Agriculture,* 334 F. 2d 570, that Court reviewed action by the Secretary of Agriculture which was challenged under 5 U. S. C. 1009 as a denial of due process. The Court stated that it made no difference whether the action was challenged substantively as being arbitrary or capricious, or procedurally as denying minimum safeguards. Administrative agency action was reviewable unless immunity therefrom was plainly the manifested intention of Congress.

28 U. S. C. 1361 provides for an action in the nature of mandamus to compel an officer or employee of the United States or any agency thereof to perform a duty owed to plaintiff.

Mandamus is properly employed to compel the performance of certain decisions which involve judgment and discretion. See *Parrott* v. *Cary* (DC Colo. 1964), 234 F. Supp. 572 and Moore's Federal Practice, Volume 7A, JC-535. See also *Sleeth* v. *Dairy Products Co., of Uniontown,* 228 F. 2d 165, cert. den. 351 U. S. 966 and *Goldberg* v. *Hoffman* (CA 7—1955), 226 F. 2d 681. It is also clear that mandamus lies to compel the person in whom discretion is lodged to pro-

ceed with its exercise. See *Connelt* v. *City of Jerseyville* (CCA Ill. 1942), 125 F. 2d 121; *Higginson* v. *Schoeneman* (CA D. C. 1951), 190 F. 2d 32; *Thomas* v. *Unison* (App. D. C. 1946), 153 F. 2d 636. The Court of Appeals for the District of Columbia also expressly approved a civil action for an injunction to deal with an administrative agency order in cases where there is no statutory appeal. See *Agnew* v. *Board of Governors of the Federal Reserve System* (CA D. C. 1946), 153 F. 2d 785, rev'd other grounds 329 U. S. 441.

In the case of *Commissariat A L'Energie Atomique* v. *Watson, Commissioner of Patents* (CA D. C. 1960), 274 F. 2d 594, the Court of Appeals reversed the District Court for the District of Columbia which had granted a motion to dismiss filed by the Commissioner of Patents on the ground that the complaint involved failed to state a cause of action and that the Court lacked jurisdiction over the subject matter. The complaint in that case sought review of the refusal of the Commissioner of Patents to revive an abandoned patent application as well as the refusal of the Patent Office Board of Appeals to reconsider its affirmance of the Patent Office Examiner's denial of a patent. The plaintiff involved asserted mandamus jurisdiction over the Commissioner of Patents for his refusal to exercise discretion and to make a finding in accordance with 35 U. S. C. 133, which deals with the revival of abandoned patent applications. The Court of Appeals went on to say that the Commissioner of Patents possesses a large measure of discretion in the question of reviewing abandoned patent applications, but even so, the statutes do not purport to make discretion plenary and unreviewable. The Commissioner's discretion cannot remain wholly uncon-

trolled. Review jurisdiction existed and the Commissioner should submit findings, especially where the plaintiff involved asserts the ability to prove facts that would cause the Commissioner in the proper exercise of his discretion to hold in their favor.

In *Kingsland, Commissioner of Patents* v. *Carter Carburetor Corp.* (CA D. C. 1945), 168 F. 2d 565, cert. den. 79 U. S. P. Q. 453, the Court of Appeals voided the Commissioner of Patents' order reversing action taken by an interference Examiner.

The United States Court of Customs and Patent Appeals in *In re Wiechert,* 152 U. S. P. Q. 247 stated that Decisions of the Commissioner of Patents were not appealable to the CCPA. The proper remedy is by mandamus in the District Court (page 255).

On two separate occasions, the Supreme Court of the United States affirmed mandamus jurisdiction to review actions of the Commissioner of Patents. *Butterworth, Commissioner of Patents* v. *United States ex rel. Hoe et al.,* 112 U. S. 50 and *United States ex rel. Steinmetz* v. *Allen,* 192 U. S. 543.

2. One of the reasons alleged by the Commissioner of Patents for refusing to act on the Doyle, Nayler and Rolinson petition and refusing to review the Interference Rules which he himself has promulgated and further as a reason why the Federal Court should not exercise their right to judicially review his action, is that Doyle, Nayler and Rolinson should proceed by Appeal to the Patent Office Board of Appeals on other separate and distinct issues. The Board of Appeals, however, does not have either the power or authority to in any way review the decision of

the Commissioner of Patents which is sought to be reviewed. The Board of Appeals may only deal with these other issues, none of which was before the District Court, Court of Appeals or this Court. The fact that Doyle, Nayler and Rolinson may argue other issues before the Patent Office Board of Appeals does not make the action on which review is sought non-final. Moreover, favorable action by the Court in this case would render the issues which might be argued before the Patent Office Board of Appeals moot. All of the issues which might be raised before the Board of Appeals are completely different from those in this case. Furthermore, proceeding before the Board of Appeals would prevent Doyle, Nayler and Rolinson from obtaining the testimony of Sheehan which they believe should be brought out in an Interference in order to ensure that they are found to be the first inventors. The Patent Office has succeeded up until the present time in preventing judicial review of the Commissioner's decision by confusing the issues and leading the Courts below to believe that the Board of Appeals should hear this case on other issues and in the event that Doyle, Nayler and Rolinson are dissatisfied with the decision of the Board of Appeals, that they may then return to the District Court and/or the Court of Appeals under the provisions of 35 U. S. C. 145.

This deprives petitioners of due process of law because in view of the fact that the issues before the Board of Appeals are completely different from those on which review is sought under 35 U. S. C. 1361 and 5 U. S. C. 1009, it is seriously doubted that adverse decision by the Board of Appeals on these different issues, could be reversed by arguing as new issues on Appeal to the District Court for

the District of Columbia, the very issues in this case. Clearly, the CCPA has no jurisdiction to hear such issues, *In re Wiechert, supra.* Doyle, Nayler and Rolinson are, therefore, at present being impaled on the horns of a dilemma. The District Court and the Court of Appeals for the District of Columbia have refused to exercise jurisdiction and have refused to review the decision of the Commissioner of Patents stating that if Doyle, Nayler and Rolinson are aggrieved by the decision of the Board of Appeals, they have the right to come back to the District Court and the Court of Appeals under 35 U. S. C. 145 after an adverse decision of the Patent Office Board of Appeals. On the other hand, Doyle, Nayler and Rolinson have no way of presenting the issues presented in this proceeding before the Board of Appeals since under the rules of the Patent Office the Board of Appeals has a separate function and considers only appeals on the merits and can neither interpret Interference rules nor review decisions issued by the Commissioner of Patents. If this Court fails to exercise jurisdiction, Doyle, Nayler and Rolinson will be left without a remedy and without a forum in which to bring forth the issues which are of grave importance for all applicants for United States patents and which also transcend the Patent Office and affect the actions of all government administrative agencies in view of the procedural approach which the Patent Office has attempted to take.

3. 35 U. S. C. 135 allows the Commissioner of Patents some measure of discretion as to the declaration of Interferences. Pursuant to that discretion, the Commissioner has promulgated rules setting forth the requirements to be met before an Interference will be declared. Effective July 1, 1965 a new set of rules was promulgated by the Com-

missioner. The Interference which was sought in this case was initially sought under the provisions of the previous rules but Doyle, Nayler and Rolinson are equally willing to have their case decided under the newly promulgated rules, because these will expedite the Interference. The Commissioner had not interpreted his new rules prior to the request from Petitioners. Doyle, Nayler and Rolinson have complied with the language and the spirit of the new rules, yet the Patent Office has refused to declare an Interference. The basis for this refusal was that Doyle, Nayler and Rolinson had failed to meet a greater burden of proof than that required by the rules. Rule 204(c) which governs the declaration of Interferences where the dates of invention of the parties are further apart than in this case, specifically requires only *prima facie* evidence of first inventorship by the later party, for the Interference to be declared (App. A, pages 28-29). Rule 204(b) under which the present Interference is sought is concerned with situations where the alleged dates are closer to each other than under Rule 204(c). Therefore, the proof requirement of Rule 204(b) is certainly not greater than the *prima facie* evidence requirement of Rule 204(c). Doyle, Nayler and Rolinson have submitted *prima facie* evidence of first inventorship in the form of affidavits and arguments, the affidavits being sworn to by three leading chemists including one of the foremost in the entire world, Sir Robert Robinson. The Patent Office (App. C, page 40) admitted that Doyle, Nayler and Rolinson had submitted *prima facie* evidence, but rejected the proof and refused to declare an Interference on the ground that they had not submitted conclusive evidence. Nowhere in the rules is there a requirement that conclusive evidence be presented. The Patent Office has, in effect, required a greater burden of proof

than Doyle, Nayler and Rolinson would have to sustain if they actually obtained a declaration of an Interference and were contesting first inventorship with Sheehan. The prevailing case law is clear in that it is only necessary for even a junior party in an Interference to prevail by a *preponderance* of the evidence, see *Cramer* v. *Kirkwood and Torre* (CCPA), 305 F. 2d 486, and *Apstein* v. *Brimley and Cance* (PO Bd. Pat. Inter.), 133 U. S. P. Q. 604. To correct this misinterpretation and misapplication of these new Interference rules, Doyle, Nayler and Rolinson, under the provisions of Rules 181 to 183 promulgated by the Commissioner, filed a Petition to the Commissioner of Patents and requested that he exercise his supervisory authority as provided in those rules, review the action of the Examiners involved and interpret the meaning of Rule 204(b) with which petitioners believe they had clearly and unquestionably complied. The Commissioner referred decision on Petitioners' petition back to Group 120 in the Patent Office which was the very group in the Patent Office which had misinterpreted the rules and refused to declare the Interference in the first instance. The manager of Group 120 rendered the decision on the petition and refused to review the action or to issue any interpretation of the Interference rules. In a case decided July 6, 1966, *Wenner* v. *Koch*, 152 U. S. P. Q. 291, Wenner petitioned the Commissioner of Patents objecting to Patent Office action under Interference Rule 204(c). First Assistant Commissioner Reynolds issued an interpretation of Rule 204(c) with respect to that specific situation.

4. In the recent case of *Brenner* v. *Manson*, 383 U. S. 519, this Court considered a potential Interference situation. In that case, however, even had Manson prevailed

in the Interference, he would have been refused a patent on the ground that his application failed to comply with 35 U. S. C. 112 because it did not teach a utility for the product produced by the process sought to be patented as required by 35 U. S. C. 101. The present case presents an entirely novel and hitherto untried approach by the Patent Office for refusing to declare an Interference which is contrary to law. The Doyle, Nayler and Rolinson application fully complies with all statutory provisions and specifically 35 U. S. C. 101 (utility) and 35 U. S. C. 112 (full and complete disclosure of the invention). If Petitioners win the Interference, a patent must be issued to them because they have complied with all the legal requirements of patentability. The Patent Office has put forward a new requirement in this case which is not supported either by Statute or case law, namely, that before an Interference will be declared, Petitioners' application must be patentable over the Sheehan patent with which the Interference is sought. This is a perverted reading of Patent Office Rule 201. Petitioners' case contains all the six claims of the Sheehan patent. Under the Manual of Patent Examining Procedure (M. P. E. P.) Section 1101.02(a) issued by the Commissioner, the only way Petitioners' application can be patentable over Sheehan's patent is through an Interference. That Section requires the institution of an Interference. Under Rule 204(b) of the Commissioner's Rules, an Interference will be declared between an application and a patent, when the applicant submits proof of first inventorship. Here, *prima facie* proof was rejected as insufficient because the Patent Office called for *conclusive* evidence.

The Commissioner has refused to correct the administrative errors and has refused even to interpret his new Interference rules as requested by Petitioners although Rule 204(c) was interpreted in response to a Petition to the Commissioner in the recent case of *Wenner* v. *Koch, supra,* after Petitioners had commenced their Court action. The Commissioner has taken the position that this arbitrary and capricious action is not reviewable and that he is, in effect, completely insulated from any judicial review. Such insulation amounts to a denial of due process of law to applicants. This is no legal basis for asserting that applicants before administrative agencies may not obtain judicial review of final and otherwise unreviewable agency action.

Doyle, Nayler and Rolinson have soundly based their request for judicial review both under 28 U. S. C. 1361 and 5 U. S. C. 1009 and have presented for judicial review issues which cannot be decided by any other judicial or quasi-judicial body, except the Federal Courts. The Commissioner of Patents has refused to act after his supervisory authority and jurisdiction were invoked pursuant to his very own rules. While under *Brenner* v. *Manson, supra,* a patent was held not to be a hunting license, it should correspondingly be true that that Patent Office is not a private game preserve where the Commissioner of Patents may act as he wishes, fully protected and insulated from judicial review.

CONCLUSION

For the foregoing reasons and in view particularly of both the novelty of the situation presented here and the wide-ranging consequences, not only in terms of future Patent Office action, but in terms of future action of all government administrative agencies, this Petition for a writ of certiorari should be granted.

Respectfully submitted,

ALBERT L. JACOBS
Counsel for Petitioner

October 13, 1967

Of Counsel:
ALBERT L. JACOBS, JR.